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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,254	11/01/2000	Blaine Garst	19004-009002	3557
26183 7590 05/14/2009 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
GREENE, DANIEL LAWSON				
ART UNIT		PAPER NUMBER		
3694				
NOTIFICATION DATE		DELIVERY MODE		
05/14/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

09/704,254

Applicant(s)

GARST ET AL.

Examiner

DANIEL L. GREENE

Art Unit

3694

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-92 and 94-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-86, 87-92, 94-147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 84-86, 88-92, and 94-147 are pending and an action on the merits of these claims follows. Claims 84, 103, 106 and 127 have been amended in the communications received 2/18/2009.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/18/2009 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 84-86, 88-92, and 94-126 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Currently claims 84-86, 88-92, and 94-126 are not tied to a particular machine or apparatus. Further, claims 84-86, 88-92, and 94-126 do not appear to transform a particular article to a different state or thing. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir 2008)

A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, *or* (2) transforms a particular article to a different state or thing. This is called the "**machine-or-transformation test**".

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

Response to Arguments

- 4. Applicant's arguments filed 2/18/2009 have been fully considered but not persuasive.**

Applicant argues on page 11 of 13:

"The basis for the Examiner's 103 rejection of the pending claims is that "MILLIONS (51,274,000 households without internet access) of reasons to have the resources residing on an isolated computer and as such are motivation for and render obvious the instant invention." This statement, however, fails to address the language of the claims which describe how to license software resources for use by a software program when both the software program and the software resources are included in the same software structure residing on a single computer. As stated in Applicants' previous responses, the cited prior art is directed to licensing schemes in a distributed computing environment where a

software program running on one computer seeks access to resources residing on other computers. Thus the cited prior art teaches a centralized licensing server for managing resource access in a distributed computing environment.”

Response:

As set forth above, Applicant’s agree that the cited prior art teaches a centralized licensing server for managing resource access in a distributed computing environment.

Resort may be had to the 1997 census report (See, page 4 of the Office action mailed 1/25/2008) as evidence that at least 59 million people of ordinary skill in the art would have been motivated to modify the cited art in order to license software resources for use by a software program when both the software program and the software resources are included in the same software structure residing on a single computer for the benefit of being able to use the software on a computer that is NOT CONNECTED to a distributed authorization system. Modifying the prior art would also provide the additional benefit of allowing software resource providers to access millions more customers with associated revenue generation.

Accordingly, the rejections set forth in sections 7 and 8 of the previous Office action are sustained and incorporated herein as reproduced below.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

6. Claims 84-86, 87-92 and 94-147 are rejected under 35 U.S.C. 103(a) as being obvious over Wyman (U.S. Patent 5,204,897) in view of Applicants Admitted Prior Art (APA) for the reasons set forth in section 10 of the 1/25/2007 Office action and further in view of In re Wolfe, 116 USPQ 443,444 (CCPA 1961) as set forth in section 4 of the 9/6/2007 Office action and further in view of Table C of the 1997 Census report.

See the discussion set forth in section 4 above as well as the discussions set forth in the 8/18/2008 and 1/25/2008 Office actions.

Regarding applicant's addition of the limitation "a license key derived from said one or more license terms, the license key for allowing the software program to access the software resource," see for example, Wyman, Col. 14, line 26 through Col. 15, line 16 wherein it is stated, inter alia:

"The signature field 53 in the product use authorization 35 is a part of a validation mechanism which provides important features. This field contains a digital signature encoded to reflect the data in the license itself..."

7. Claims 84-86, 87-92 and 94-147 are rejected under 35 U.S.C. 103(a) as being obvious over Ross (U.S. Patent 5,553,143) in view of Applicants Admitted Prior Art (APA) for the reasons set forth in section 11 of the 1/25/2007 Office action and further in view of In re Wolfe, 116 USPQ 443, 444 (CCPA 1961) as set forth in section 4 of the 9/6/2007 Office and further in view of Table C of the 1997 Census report.

See the discussion set forth in section 4 above as well as the discussions set forth in the 8/18/2008 and 1/25/2008 Office actions.

Regarding applicant's addition of the limitation "a license key derived from said one or more license terms, the license key for allowing the software program to access the software resource.", see for example, Ross, Abstract wherein it is stated, inter alia:

"Portions of a license document can be encrypted using a private key and message digests. The encrypted result can be stored in the license document, and examined to validate a license."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./
Examiner, Art Unit 3694
2009-05-10

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694